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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/738,013	12/14/2000	Herbert D. Jellinek	FUSN1-01304US0	1471

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EXAMINER

POLLACK, MELVIN H

ART UNIT	PAPER NUMBER
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2145

DATE MAILED: 02/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/738,013

Applicant(s)

JELLINEK, HERBERT D.

Examiner

Melvin H Pollack

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 10-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 10-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/2/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: see attached office action.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 10/26/04 have been fully considered but they are not persuasive. The reasons for such analysis are provided below.
2. Due to the amendments to the specification, the objection to the title is withdrawn.
3. Due to the cancellation of claims 7-9, the related 112 rejection is withdrawn.
4. Regarding claims 12 and 13 vs. claims 10 and 11, the applicant states that claims 12 and 13 are broader. More specifically, it states that claim 12 allows for modifying a link anywhere within the method of claim 2, whereas claim 10 requires the modification to be within step d of claim 2. Given the structure of the claim 2 method, the required structure of the unmodified link, and the applicant's admission that the link may be wrapped only once (P. 12, lines 7-12), the examiner concludes that the modification must occur between identifying the link (step c) and delivering the modified link (step e), where step d clearly delineates the modifying process. Thus claims 12 and 13 are redundant and hence lead to indefiniteness.
5. Due to the amendment of claim 14, the related 112 rejection is withdrawn.
6. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "information remains on the network server, which still must be accessed" (P. 14, lines 11-12)) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). This limitation does not appear in any of the claims, and is not implicit in the broad descriptions of the server activities. The phrases "that are

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only resolvable within said local network” and “information identifying said server” are not sufficient to include all meets and bounds of this cited limitation.

7. The claims also do not teach “the present invention is directed to allowing access to non-resolvable hyperlinks within electronic content. (P. 14, lines 7-8).” Furthermore, such language is non-statutory as it is clear that at least one server CAN resolve the hyperlink. If the applicant wishes to amend the claims to add this limitation, he should clarify that the requesting client’s local server cannot resolve the hyperlink.

8. In response to applicant's argument that the purpose of the invention is for resolving non-resolvable hyperlinks rather than related to page caching, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

9. In regards to Mantha, the purpose is to copy web pages, as stated by applicant. However, the inventive feature is to modify the hyperlinks within said document that are non-resolvable except within a local network, in this case because the base link (original server reference) is missing, i.e. the desired electronic content is an image, and the web designer used URLs based solely on the image folder. As such, the system must retrieve the images and other data from the remote server that “are only resolvable within said local network,” i.e. the images, and then further must modify the links to point correctly to the data. While many of the links point to

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local storage (Fig. 12, #91), many others of the links are modified by adding the full name of the server to each link (Fig. 12, #92). For example, if the main page of artscape.com is saved, "" becomes "". (See Fig. 14). Hence, a link originally resolvable only on the network where artscape.com is located becomes resolvable on the client computer on a separate local network because the link is modified to include information identifying said server. Please note that the file "ceramics.html" is *not* being saved to the hard drive of the computer, and hence must be later retrieved using the modified link.

10. For the reasons above, the original rejection stands. Therefore, this action is final.

Claim Rejections - 35 USC § 112

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 12 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

13. Claims 12 and 13 are considered indefinite by the office because they are functionally equivalent to claims 10 and 11, and encompass the same scope. The office considers redundancies such as these to be inherently indefinite. Either claims 12 and 13 must be amended and/or cancelled, or claims 11 and 12 must be amended and/or cancelled.

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

15. Claims 1-6, 10-20, 22-33, and 35-42, 44-46 are rejected under 35 U.S.C. 102(e) as being anticipated by Mantha et al. (6,163,779).

16. For claim 1, Mantha teaches a method (see abstract) for processing requests for delivery of electronic content (col. 1, lines 5-10), comprising the computer-implemented steps (col. 4, lines 10-30) of:

- a. Receiving at a server (Fig. 1, #12) on a local network, a request for delivery to a destination client (Fig. 1, #10) that is not on the local network, of electronic content that is associated with the local network (col. 1, lines 20-40), wherein the electronic content includes one or more links that are only resolvable within said local network (col. 2, lines 10-20 and 50-65);
- b. Retrieving the electronic content from within the local network (col. 2, lines 45-50);
- c. Generating updated content by modifying the one ore more links associated with the electronic content to include information identifying said server (col. 2, lines 50-62);
and
- d. Delivering said updated content to said destination client (col. 1, lines 60-65).

17. For claim 2, Mantha teaches a method (see abstract) for providing information from a network (col. 1, lines 5-10) including a network device (Fig. 1), said method comprising the steps of:

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- a. Receiving a request for a first electronic content from said network (col. 1, lines 20-40);
 - b. Retrieving said first electronic content from said network (col. 2, lines 45-50; Fig. 9);
 - c. Identifying a link within said first electronic content (Fig. 10);
 - d. Wrapping said link to obtain a wrapped version of said link (Fig. 12, #92); and
 - e. Delivering a modified version of said first electronic content, wherein said modified version of said first electronic content includes said wrapped version of said link (col. 10, lines 60-65).
18. For claim 3, Mantha teaches that the first electronic content is an electronic document (Fig. 9, #61; Fig. 14, #115) and said modified version of said first electronic content is a modified version of said electronic document (Fig. 9, #70; Fig. 14, #117).
19. For claim 4, Mantha teaches that said link is a URL and said modified version of said link is a modified version of said URL (col. 1, lines 20-40).
20. For claim 5, Mantha teaches that said link includes an external address portion identifying said network device (Fig. 15, "www.artscape.com"), and an internal address portion identifying a second electronic content within said network (Fig. 15, "/ceramics.html").
21. For claim 6, Mantha teaches that said external address portion can be resolved outside said network, and said internal address portion cannot be resolved outside said network and can be resolved in said network (col. 12, lines 8-35).
22. For claim 10, Mantha teaches that wrapping includes inserting a reference to said network device in said modified link (Fig. 14, #117).

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23. For claim 11, Mantha teaches that said link does not include a reference to said network device (Fig. 14, #115).

24. Claims 12 and 13 have the same limitations as claims 10 and 11, and therefore should be cancelled or amended.

25. For claim 14, Mantha teaches that said link includes an address for a third electronic content in said network and said modified version of said link includes an address for said third electronic content in said network (Fig. 14; "<A HREF>" tags).

26. For claim 15, Mantha teaches that the method includes identifying additional links within said first electronic content; and wrapping said additional links to obtain wrapped versions of said additional links (Fig. 12, #85).

27. For claim 16, Mantha teaches determining said additional links cannot be resolved outside of said network (Fig. 12).

28. For claim 17, Mantha teaches that said modified version of said first electronic content contains said wrapped versions of said additional links (Fig. 16).

29. For claim 18, Mantha teaches that said request originates outside of said network (col. 4, lines 10-30).

30. For claim 19, Mantha teaches that said request originates inside of said network (col. 4, lines 10-30).

31. For claim 20, Mantha teaches that verifying that said address is fully qualified (col. 11, lines 50-65).

32. Claims 22-26 are drawn to a software system that implements the method drawn in claims 2-7, respectively. It is well known in the art that a system implementation is functionally

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equivalent to the underlying method. Therefore, since claims 2-7 are rejected, claims 22-26 are also rejected for the reasons above. A teaching that shows the functional equivalence will be included upon request.

33. Claim 27 is drawn to a software system that implements the method drawn in claims 8 and 9. It is well known in the art that a system implementation is functionally equivalent to the underlying method. Therefore, since claims 8 and 9 are rejected, claim 27 is also rejected for the reasons above. A teaching that shows the functional equivalence will be included upon request.

34. Claims 28-33 are drawn to a software system that implements the method drawn in claims 10, 11, 14, 15, 17, and 20, respectively. It is well known in the art that a system implementation is functionally equivalent to the underlying method. Therefore, since claims 10, 11, 14, 15, 17, and 20 are rejected, claims 28-33 are also rejected for the reasons above. A teaching that shows the functional equivalence will be included upon request.

35. Claim 35 is drawn to a hardware system that implements the method drawn in claim 2. It is well known in the art that a system implementation is functionally equivalent to the underlying method. Therefore, since claim 2 is rejected, claim 35 is also rejected for the reasons above. A teaching that shows the functional equivalence will be included upon request.

36. Claim 36 is drawn to a hardware system that implements the method drawn in claims 5 and 6. It is well known in the art that a system implementation is functionally equivalent to the underlying method. Therefore, since claims 5 and 6 are rejected, claim 36 is also rejected for the reasons above. A teaching that shows the functional equivalence will be included upon request.

37. Claim 37 is drawn to a hardware system that implements the method drawn in claims 7-9. It is well known in the art that a system implementation is functionally equivalent to the

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underlying method. Therefore, since claims 7-9 are rejected, claim 37 is also rejected for the reasons above. A teaching that shows the functional equivalence will be included upon request.

38. Claims 38-42 are drawn to a hardware system that implements the method drawn in claims 10, 14, 15, 17, and 20, respectively. It is well known in the art that a system implementation is functionally equivalent to the underlying method. Therefore, since claims 10, 14, 15, 17, and 20 are rejected, claims 38-42 are also rejected for the reasons above. A teaching that shows the functional equivalence will be included upon request.

39. Claims 44 and 45 are drawn to the limitations in claims 2 and 10, respectively. Mantha teaches the added limitation of determining whether a link should be resolved (Fig. 12, #87-89). Therefore, since claims 2 and 10 are rejected, claims 44 and 45 are also rejected for the same rationale.

40. Claim 46 is drawn to the limitations in claim 44. Mantha teaches the added limitation of multiple links (Fig. 12, #87) over multiple pages (Fig. 13, #93). Therefore, since claim 44 is rejected, claim 46 is also rejected for the reasons above.

Claim Rejections - 35 USC § 103

41. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

42. Claims 21, 34, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mantha as applied to claims 2, 22, and 35 above, and further in view of Rodkin et al.

(6,581,065).

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43. For claim 21, Mantha does not expressly disclose inserting a second link into said modified version of said first electronic content, wherein said second link addresses a fourth electronic content not addressed by any link in said first electronic content. Rodkin teaches a method (see abstract) for modifying text files in a client server network (col. 1, lines 10-22) in which hyperlinks are added to the electronic document based on text data strings (col. 3, line 65 – col. 4, line 30). At the time the invention was made, one of ordinary skill in the art would have used the Rodkin hyperlink method to modify electronic content in order to simplify link updating (col. 3, lines 15-60).

44. Claim 34 is drawn to a software system that implements the method drawn in claim 21. It is well known in the art that a system implementation is functionally equivalent to the underlying method. Therefore, since claim 21 is rejected, claim 34 is also rejected for the reasons above. A teaching that shows the functional equivalence will be included upon request.

45. Claim 43 is drawn to a hardware system that implements the method drawn in claim 21. It is well known in the art that a system implementation is functionally equivalent to the underlying method. Therefore, since claim 21 is rejected, claim 43 is also rejected for the reasons above. A teaching that shows the functional equivalence will be included upon request.

Conclusion

46. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin H Pollack whose telephone number is (571) 272-3887. The examiner can normally be reached on 8:00-4:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on (571) 272-6159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MHP
08 February 2005


Jason Carones
Primary Examiner
AU: 2145